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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,763	09/17/2003	Hiroyuki Kobayashi	8048-1032	3833
466	7590	09/13/2007	EXAMINER	
YOUNG & THOMPSON			TOPGYAL, GELEK W	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/663,763	KOBAYASHI ET AL.
	Examiner	Art Unit
	Gelek Topgyal	2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 9/17/2003.
- 2a) This action is **FINAL**.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-24 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 17 September 2003 is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 9/17/2003.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Specification***

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Official Gazette notice of 22 November 2005), Annex IV, reads as follows:

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation function." The New IEEE Standard Dictionary of Electrical and Electronic Terms 308 (5<sup>th</sup> ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held statutory).

In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

**Claims 21-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claims 21-24 define a computer program product embodying functional descriptive material. However, the claim does**

not define a computer-readable medium or memory and is thus non-statutory for that reason (i.e., "When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized" – Guidelines Annex IV). That is, the scope of the presently claimed *computer program product* can range from a paper on which the program is written, to a program simply contemplated and memorized by a person. The examiner suggest amending the claim to embody the program on "computer-readable medium" or equivalent in order to make the claim statutory. Any amendment to the claim should be commensurate with its corresponding disclosure.

It is suggested the claims 21-24 read as follows: "A computer-readable medium storing a computer program product for tangibly embodying a computer program of instructions executable by a computer ..."

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical

Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. **Claims 1-24** are rejected under 35 U.S.C. 102(e) as being anticipated by Schoner et al. (US 6,493,506).

**Regarding apparatus claims 1 and 6**, Schoner et al. teaches an information reproducing apparatus (Fig. 1, optical disk system 10) for reproducing audio information and a plurality of still picture information units on the basis of reproduction control information for indicating reproduction starting time points of the respective plurality of still picture information units to be reproduced during a reproduction of the audio information, the information reproducing apparatus comprising:

an audio reproducing device for reproducing the audio information (Fig. 1, Audio DAC 26 and supporting disclosure);

a still picture reproducing device for reproducing the plurality of still picture information units in sequence by switching the plurality of still picture information units one after another according to the reproduction starting time points (Col. 7, lines 30-47 teaches navigation data that control playback of the multiple pictures or frames stored on the medium);

a storing device for storing information, as interruption information, to identify a still picture information unit that is reproduced until the reproduction by the audio reproducing device or the still picture reproducing device is interrupted (Col. 11, lines

49-67 teaches wherein when a playback is interrupted (stopped), the location of the interruption is stored in nonvolatile memory portion 34. The location information as taught in col. 11, lines 8-16 recites that a particular location within the multiple pictures or frames are stored. The VOBU unit is the nearest picture information unit as stored in the location information. When the system is interrupts the playback, both the image output and the audio output are interrupted); and

    a setting device for setting a reproduction resuming position of the audio information, on the basis of the interruption information that is stored in the storing device (Col. 11, lines 53-59).

**Regarding claim 2**, Schoner et al. teaches the claimed wherein:

    the audio information includes a plurality of audio information units (as discussed in claim 1 above, and furthermore, col. 11, lines 8-16 teaches wherein video information and audio information are stored in VOBUs. The VOBUs have multiple audio packs (units)),

    the reproduction control information indicates a reproduction starting time points of the respective plurality of still picture information units to be reproduced during a reproduction of any one of or each of the plurality of audio information units (as discussed in claim 1 above, when the interruption of playback takes place, both audio and image information are also interrupted. Therefore location information allows for the system to resume playback from where the interruption took place, i.e. the location where both audio and image information are located),

the storing device stores, in addition to the interruption information, unit designation information to designate an audio information unit that is reproduced until the reproduction by the audio reproducing device or the still picture reproducing device is interrupted (as discussed above, both audio and image information are stored in the location information), and

the setting device sets the reproduction resuming position of the audio information on the basis of the unit designation information and the interruption information, which are stored in the storing device (as discussed in claim 1 and this instant claim above).

**Regarding claim 3**, Schoner et al. teaches the claimed wherein the interruption information is reproduction control information of the still picture information unit that is reproduced until the reproduction is interrupted (as discussed in claims 1 and 2 above).

**Regarding claim 4**, Schoner et al. teaches the claimed wherein the interruption information is designation information to designate reproduction control information of the still picture information unit that is reproduced until the reproduction is interrupted (as discussed in claims 1 and 2 above, and furthermore, col. 11, lines 29-41 teaches that the microprocessor 16 uses the location information stored in the non-volatile memory 34 to resume playback from the previously interrupted position).

**Regarding claim 5**, Schoner et al. teaches the claimed wherein the interruption information is designation information to designate the still picture information unit that is reproduced until the reproduction is interrupted (as discussed in claim 4 above).

**Claim 7** is rejected for the same reasons as discussed in claim 2 above.

**Claims 8-10** are rejected for the same reasons as discussed in claims 3-5, respectively, and furthermore, col. 11, lines 8-16 teaches wherein the location of a VOBU is stored as location information. Therefore the VOBU unit is the nearest picture information unit as stored in the location information.

**Claims 11 and 14** are rejected for the same reasons as discussed in claims 1 and 6 above.

**Claim 12** is rejected for the same reasons as discussed in claim 2 above, and furthermore, during playback from the stored location information, both audio and image information are output using the location information.

**Claim 13** is rejected for the same reasons as discussed in claim 12 above.

**Claims 15-16** are rejected for the same reasons as discussed above in claims 12-13, respectively.

**Method claims 17-20** are rejected for the same reasons as discussed above in apparatus claims 1, 6, 11 and 14, respectively.

**Computer program product claims 21-24** are rejected for the same reasons as discussed above in apparatus claims 1, 6, 11 and 14, respectively.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
6. The cited references teach systems that allows for the last position played to be stored to allow quicker playback.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gelek Topgyal whose telephone number is 571-272-8891. The examiner can normally be reached on 8:30am -5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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8/30/2007

GT  
THAI D. TRAN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600